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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,687	03/29/2001	Eiji Natori	109121	3151

25944 7590 01/14/2004

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EXAMINER

GUERRERO, MARIA F

ART UNIT PAPER NUMBER

2822

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,687

Applicant(s)

NATORI, EIJI

Examiner

Maria Guerrero

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-40 and 52-60 is/are pending in the application.
- 4a) Of the above claim(s) 11-22, 52-55 and 60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-40 and 56-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

1. This Office Action is in response to the Amendment filed October 8, 2003.

Claims 1-10 and 41-51 are canceled.

Claims 11-40 and 52-56 are pending.

Election/Restrictions

2. This application contains claims 11-22, 52-55 drawn to an invention nonelected with traverse in Paper No. 10. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Newly submitted claim 60 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 60 recites a ceramic fabrication device.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 60 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 23-24 and 56–59 are rejected under 35 U.S.C. 102(b) as being anticipated by Mikoshiba et al. (U.S. 5,753,320) (cited on IDS).

Mikoshiba et al. teaches feeding an electromagnetic wave and active species of a substance, which is at least part of raw material to a region on a substrate to form a ceramic film (Abstract, col. 3, lines 1-20, col. 18, lines 53-65). Mikoshiba et al. shows a means for forming ceramic film including s means for feeding an electromagnetic wave and active species to the region smaller than the entire surface of the substrate (Fig. 1A, 4A-5, Abstract, col. 5, lines 50-65).

In addition, the elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

4. Claims 23-40 and 56–59 are rejected under 35 U.S.C. 102(e) as being anticipated by Paz de Araujo et al. (U.S. 6,110,531).

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5. Paz de Araujo et al. teaches feeding an electromagnetic wave and active species of a substance, which is at least part of raw material to a region on a substrate to form a ceramic film (col. 6, lines 50-55, col. 9, lines 8-40). Paz de Araujo et al. teaches a method of mixing a ferroelectric precursor with an active species and applying the film by misted CVD process (Fig. 3, col. 5, lines 21-30, 45-56, col. 13, lines 50-65, col. 14, lines 1-10). Paz de Araujo et al. discloses the active species being a radical or ion of the raw material species (Fig. 3, col. 5, lines 21-30, col. 8, lines 8-30). Paz de Araujo et al. shows the active species being oxygen or nitrogen or inert argon gas, the active species being fed to the substrate (Fig. 3). Paz de Araujo et al. teaches forming a first ceramic film in an amorphous state (having low crystallinity) (col. 2, lines 19-25, col. 14, lines 50-65). Paz de Araujo et al. shows the thickness of the film being in the range of 50 to 5000 angstroms (col. 4, lines 24-27).

6. Paz de Araujo et al. teaches a means for forming ceramic film including s means for feeding an electromagnetic wave and active species to the region smaller than the entire surface of the substrate (Fig. 2, 4, col. 6, lines 1-55).

In addition, the elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Response to Arguments

7. Applicant's arguments with respect to claims 23-40, 56-59 have been considered but are moot in view of the new ground(s) of rejection.

C nclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria Guerrero whose telephone number is 571-272-1837.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amir Zarabian can be reached on 571-272-1852. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to 571-272-2800.

Maria Guerrero
Maria Guerrero
Patent Examiner
January 12, 2003